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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,167	07/05/2001	Roman Fuchs	ATM-2129-1	9618

7590 06/16/2003
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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/16/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,167

Applicant(s)

FUCHS ET AL.

Examiner

D. S. Nakarani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/902,964.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed July 2, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: column 8, line 28 changing the phrase "protective layers are typically 1 nm thick" to the phrase -- protective layers are typically from 1 nm thick -- introduces new matter because the addition of the word "from" to the phrase allows the thickness range of the protective layers to open ended while the original phrase limits to "1 nm thick protective layers".

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claims 1-15 stand rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Column 8, line 28, changing the phrase "protective layers are typically 1 nm thick" to the phrase -- protective layers are typically from 1 nm thick -- introduces new matter because the addition of the word "from" to the phrase allows the thickness range of the protective layers to open ended while the original phrase limits to "1 nm thick protective layers".

3. Applicant's arguments filed March 12, 2002 have been fully considered but they are not persuasive. In reference to objection of amendment filed July 2, 2002 under 35 USC 132

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because it introduce new matter in the disclosure, applicants argue that the Preliminary Amendment dated July 2, 2002 (not as stated June 26, 2002 which is appears to be error) did not amend anything but instead set out the basis for the amendment in the specification when the reissue application was filed. On this ground alone this objection is in error.

These arguments are unpersuasive. The Examiner agrees with applicants that the Preliminary Amendment filed July 2, 2002 did not amend the specification. However there is no amendment in the file to show when and how the specification was amended. If the Preliminary Amendment filed July 2, 2002 did not amend specification, the applicants should provide when and how the specification was amended.

In reference to new matter rejection, applicants points to the C.C.P.A., In re Lange, 644 F.2d 856 and In re Oda et al, 170 USPQ 268 (C.C.P.A. 1971) and argue that the dependent claims 12 does not recite any thickness or thickness range for the transparent protective layer or layers. The thickness of the transparent protective layer in dependent claim 12 is "open ended" in both direction. This shows that the disclosure of patent 5,919,561 teaches that the upper side of the thickness (range) of the transparent protective layer can be so-called "open ended". It would be obvious to one skilled in the art that the recitation "typically 1 nm thick" was an error and illogical when the transparent protective layer was "preferably from 40 to 200 nm thick". One skilled in the art would not typically use a one nm thickness when the preferred thickness is from 40 to 200 nm. Applicants also points to U.S. Patents 5,403,657, 5,527,572 and 5,663,001 wherein one of joint invention Roman Fuchs of this patent 5,919,561 is also a joint inventor and these patents disclose individual layers are typically 1 to 200 nm, preferably 1 to 100 nm thick.

Thus one skilled in the art and joint inventor Roman Fuchs use typical thickness ranges that span or encompass preferred thickness ranges.

These arguments are unpersuasive because the recited cases are related to the typographical errors. Which are different than in the instant case.

In claim 12, the thickness of the protective layer is not recited and therefore it is open ended argument is unpersuasive because when thickness is not recited in the claim, one skilled in the art would use disclosure as a dictionary to find thickness. In the instant case the protective layer(s) can be either 1 nm thick or from 40 to 200 nm thick. There is no evidence showing that the thickness of the protective layer can be higher than 200 nm. Which is encompassed by open-ended limitation. Further there is no affidavit of fact by an expert provided showing that the thickness of the protective layer can be open-ended.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is 703-308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

D. S. Nakarani/mn
June 8, 2003


D. S. NAKARANI
PRIMARY EXAMINER